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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/537,777 | 06/06/2005 | Tomoaki Mori | 07409.0042 | 4874 |

22852 7590 04/13/2007
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| EXAMINER |
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HUNTER, ALVIN A

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| ART UNIT | PAPER NUMBER |
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3711

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/13/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/537,777 | Applicant(s) MORI ET AL. | |
| | Examiner Alvin A. Hunter | Art Unit 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/06/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because abstract is more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Shiell et al. (USPN 6969326).

Regarding claim 13, Deshiell et al. discloses a golf club head comprising outer shell structure portions including a hosel portion, a face portion, a sole portion, a crown portion, a side portion, and a joining portion where a crown member used in the crown portion is bonded to a member used in another outer shell portion wherein the crown member is formed of a fiber reinforced material and the member used in said another outer shell structure portion is formed of a metal and the crown member has an equivalent rigidity not more than 0.8 times as high as that of a sole member used in the sole portion, the equivalent rigidity of a member used in each portion is defined as a product of a thickness of the relevant member and an elastic modulus of the member in a direction in which a golf ball-striking surface of the face portion is oriented. This is because Deshiell et al. discloses both the elastic modulus and the rigidity of all of the

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members and materials used within the club head. Being that the sole portion can be thicker than the crown member and the crown member has a elastic modulus less than that of the sole member, the crown rigidity would be less than 0.8 times that of the sole. One having ordinary skill in the art would have found it obvious to have the crown member of any rigidity so long as the COR is improved.

Regarding claim 14, Deshiell et al. disclose the fiber-reinforced material being a fiber reinforced plastic.

Regarding claim 15, see the above regarding claim 13. Also, Deshiell et al. discloses two of the laminates being oriented at 45 degree angles and two laminates being 45 and 90 degrees constituting at least 50% of the laminates. The crown member also has a thickness of 0.7 to 2mm.

Regarding claim 16, see the above regarding claim 13.

Regarding claim 17, see the above regarding claims 14.

Regarding claim 18, see the above regarding claim 15. Also, a 45 degree angle would inherently be slanted in comparison to a 0 or 90 degree angle.

Regarding claim 19, see the above regarding claims 13 and 15.

Regarding claim 20, see the above regarding claim 13.

Regarding claim 21, see the above regarding claim 14.

Regarding claim 22, see the above regarding claim 18.

Regarding claim 23, see the above regarding claim 13, 15, and 18.

Regarding claim 24, see the above regarding claims 13, 15, and 18.

Regarding claim 25, see the above regarding claims 13, 15, and 18.

Double Patenting

Claims 13 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of copending Application No. 10/537,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant only discloses that the crown member is no more than 0.8 times that of the sole member whereas application No. 10/537,776 discloses that the ratio is 0.75 or less and that the ratio is based off of which is higher or lower, meaning that the crown may have a rigidity less than the crown or vice versa. Because of such, the instant claims are anticipated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 571-272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

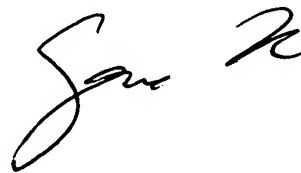
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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



EUGENE KIM
SUPERVISORY PATENT EXAMINER